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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH L. GARGIULO

Appeal 2008-2608
Application 09/965,753
Technology Center 3600

Decided: ¹ February 12, 2009

Before: WILLIAM F. PATE, III, JENNIFER D. BAHR and
STEVEN D.A. MCCARTHY, *Administrative Patent Judges*.

PATE, III, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 from a rejection of claims 1-27. We have jurisdiction under 35 U.S.C. § 6(b).

The claims are directed to a system and method for increasing the functionality of traditional postage metering systems. (Spec. pg. 5).

Claim 1 is illustrative of the claimed subject matter and is reproduced below:

1. A postage metering system for dispensing postage, the system comprising:

a modem for receiving an incoming telephone call;

a printer module for printing on a recording medium;

a control system in operative communication with the modem and the printer module; the control system for:

storing a voice message associated with the telephone call;

translating the voice message into a computer based text;

printing a print message from the computer based text using the printer module; and

sending the voice message and print message to a central server.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Daniels	US 4,556,944	Dec. 3, 1985
Kulpa	US 4,744,554	May 17, 1988
Doeberl	US 5,310,128	May 10, 1994
McCutcheon	US 6,161,007	Dec. 12, 2000
Dietz	US 6,175,820 B1	Jan. 16, 2001
Pigos	US 6,370,521 B1	Apr. 9, 2002

The Examiner rejected claims 1, 5, 6, 10, 14-15, 19 and 23-24 under 35 U.S.C. 103(a) over Daniels in view of Dietz and further in view of Pigos; claims 2-3, 11-12 and 20-21 under 35 U.S.C. 103(a) over Daniels in view of Dietz and Pigos and further in view of Kulpa; claims 4, 7-8, 13, 16-17, 22 and 25-26 under 35 U.S.C. 103(a) over Daniels in view of Dietz, Pigos and Kulpa and further in of Doeberl; claims 9, 18 and 27 under 35 U.S.C. 103(a) over Daniels in view of Dietz, Pigos, Kulpa, and Doeberl and further in of McCutcheon.

Appellant contends the Examiner erred in making each of the above rejections.

ISSUES

1. Has Appellant established that the Examiner erred in rejecting claims 1, 5-6, 10, 14-15, 19 and 23-24 under 35 U.S.C. 103(a) over Daniels in view of Dietz and further in view of Pigos?
2. Has Appellant established that the Examiner erred in rejecting claims 2-3, 11-12 and 20-21 under 35 U.S.C. 103(a) over Daniels in view of Dietz and Pigos and further in view of Kulpa?

3. Has Appellant established that the Examiner erred in rejecting claims 4, 7-8, 13, 16-17, 22 and 25-26 under 35 U.S.C. 103(a) over Daniels in view of Dietz and Pigos and Kulpa and further in of Doeberl?
4. Has Appellant established that the Examiner erred in rejecting claims 9, 18 and 27 under 35 U.S.C. 103(a) over Daniels in view of Dietz and Pigos and Kulpa and Doeberl and further in view of McCutcheon?

FINDINGS OF FACT

1. An object and advantage of Appellant's invention is to leverage the investment that the customer has already made in a postage metering system by using the embedded systems that are already present in new ways (Spec. p. 5, ll. 9-11). The postage metering system 100 used to practice the invention may be of any conventional architecture (Spec. p. 7, l. 14) including an envelope hopper 112 of conventional design, envelope feeder 122 of conventional design, tape hopper 114 of conventional design, tape feeder 124 of conventional design, transport 130 of conventional design (Spec. p. 7, l. 4 – p. 8, l. 2), and a control system 160 of conventional design (Spec. p. 9, ll. 10-12). In a preferred embodiment the invention may be practiced by using existing systems associated with the postage metering system 100, such as the processor 162, modem 180 (Spec. p. 3, ll. 5-6), user interface 170, printing system 140, recording medium 30, network and data center 50, and modifying only software. (p. 11, l. 13 et seq.).

2. Daniels describes an improvement to postage metering systems (col. 1, ll. 6-23) whereby a postage metering system (col. 1, ll. 43-61) having a printer 32 connected to a control system (processor 16) with memory 15,

also includes a voice recognition subsystem 38 (col. 3, ll. 5-10, 21, and 29-30). See also Fig. 1.

3. Dietz is primarily concerned with improvements in existing voice recognition systems, namely speech-to-text systems.

4. Dietz teaches that input data such as sounds (col. 4, ll. 10-11) or speech audio events may be input to a computer 15 via input devices 301 such as a microphone 19, 53 or telephone 23, 49 (col. 4, ll. 30-34 and 47-48). The input data may be stored (col. 4, l. 15), digitized (col. 4, l. 13), transmitted via a telephone or modem (col. 4, l. 17-20), and subject to speech-to-text conversion 305A (col. 6, l. 9).

5. Dietz additionally teaches that the text output from the speech-to-text processing step 404 may be marked up 412 for example by bolding or italicizing (col. 4, l. 67) text based on parameters of the captured sound 410 such as volume pitch and rate (col. 5, ll. 26-27).

6. Doeberl demonstrates that strips of tape (Abstract) are known to be used in the art of postage metering machines (col. 1, ll. 9-10).

7. Pigos teaches a system which focuses on a job tracking data application that collects data from mail processing devices such as postage meters (col. 2, ll. 61-66) via a network (col. 3, ll. 6-7) on a central server 10, 100 for distribution (col. 4, ll. 11-12).

8. McCutcheon teaches control systems capable of retrieving 608, storing and printing 610 header information. (col. 3, l. 33 – col. 4, l. 8; col. 6, ll. 15-20; Fig. 6).

PRINCIPLES OF LAW

Where an Appellant's remarks do not point to any specific language within the claims to distinguish over the prior art, those remarks amount to a general allegation that the claims define a patentable invention. Such allegations will not be considered an argument for separate patentability. 37 C.F.R. § 41.37(c)(1)(vii) (2008).

In *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997), the court stated:

It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable. *See In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990) (“The discovery of a new property or use of a previously known composition, even when that property and use are unobvious from prior art, can not impart patentability to claims to the known composition.”); *Titanium Metals Corp. of Am. v. Banner*, 778 F.2d 775, 782 (Fed. Cir. 1985) (composition claim reciting a newly discovered property of an old alloy did not satisfy section 102 because the alloy itself was not new); *In re Pearson*, 494 F.2d 1399, 1403 (CCPA 1974) (intended use of an old composition does not render composition claim patentable); *In re Zierden*, 411 F.2d 1325, 1328 (CCPA 1969) (“[M]ere statement of a new use for an otherwise old or obvious composition cannot render a claim to the composition patentable.”); *In re Sinex*, 309 F.2d 488, 492 (CCPA 1962) (statement of intended use in an apparatus claim failed to distinguish over the prior art apparatus); *In re Hack*, 245 F.2d 246, 248 (CCPA 1957) (“the grant of a patent on a composition or a machine cannot be predicated on a new use of that machine or composition”); *In re Benner*, 174 F.2d 938, 942 (CCPA 1949) (“no provision has been made in the patent statutes for granting a patent upon an old product based solely upon discovery of a new use for such product”).

(Citations to reporters other than the Federal Reporter system omitted.)

To rely on a reference under 35 U.S.C. 103, it must be analogous prior art. To determine what is “analogous prior art” for the purpose of analyzing the obviousness of the subject matter at issue, any need or problem known in the field of endeavor at the time of the invention and addressed by the patent or application at issue can provide a reason for combining the elements in the manner claimed. *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1742 (2007). Thus a reference in a field different from that of applicant’s endeavor may be reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his or her invention as a whole. *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379-80 (Fed. Cir. 2007). While Patent Office classification of references and the cross-references in the official search notes of the class definitions are some evidence of “nonanalogy” or “analogy” respectively, the similarities and differences in structure and function of the inventions carry far greater weight. *In re Ellis*, 476 F.2d 1370, 1372 (CCPA 1973).

Reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. *In re Gorman*, 933 F.2d 982, 986 (Fed. Cir. 1991) (Court affirmed a rejection of a detailed claim to a candy sucker shaped like a thumb on a stick based on thirteen prior art references.).

ANALYSIS

Appellant makes a general allegation (Br. p. 9-10) that the references are not properly combinable. As noted above in Finding of Fact 2, Daniels discloses a postage metering system which can accept control commands

from a voice recognition subsystem. Dietz discloses an improved voice recognition and text-to-speech computer system. Findings 3-5. In view of the limited vocabulary of commands that the system of Daniels can accept, and the advanced text-to-speech capabilities disclosed in Dietz, it would have been obvious to improve the capabilities of the Daniels postage metering system by the inclusion of the known elements and techniques of the Dietz text-to-speech system. The inclusion of these known elements and techniques in Daniels would have yielded predictable results.

Claim 1 recites a control system “for” performing four method steps on information received through the incoming telephone call. This is not a case where the nature of a programmable general purpose control system may have been altered by combination with software or instructions for performing enumerated tasks. The Appellant’s use of the word “for” to preface the four recited method steps signals that the method steps merely represent new uses of the control system specifically and the postage metering system in general. The Appellant does not suggest that programming a control system such as Daniels’ to perform these method steps would be beyond the level of skill in the art. The recitation of these new uses for a component of an otherwise obvious postage metering system do not impart patentability the claims. *See Schreiber*.

As to the Pigos reference, the connection of the postage meter of Daniels to a central server would have been prima facie obvious as is clearly suggested in Pigos.

In asserting that the Examiner erred in rejecting claims 1, 5-6, 10, 14, 15, 19 and 23-24 under 35 U.S.C. 103(a) over Daniels in view of Dietz and

further in view of Pigos (Brief p. 11-13), Appellant individually argues only claims 1, 5 and 6. Accordingly, claims 10 and 19 will stand or fall with claim 1; claims 14 and 23 will stand or fall with claim 5; and claims 15 and 24 will stand or fall with claim 6.

Appellant argues that the Examiner erred in rejecting claim 1 because Dietz does not contemplate or suggest answering telephone calls or taking telephone messages. Claim 1 does not require a telephone answering machine, nor is such a machine mentioned in claim 1. A telephone answering machine is generally understood to be a machine that records telephone voice messages. Claim 1 does not include the function of recording telephone voice messages. Claim 1 includes a modem which is a device for receiving modulated data streams already in machine readable form. Claim 1 further includes a control system which has a function of storing voice messages “associated” with telephone calls. The limitation “associated with the telephone call” fails to specify that the voice message is part of the call—it could merely be a voice memo referencing the call—and since the incoming telephone call of the claim was received by the modem, it does not appear to be a voice message anyway. Indeed, the disclosures of Daniels and Dietz, which both specify microphones, appear to be more capable of recording voice messages than appellant’s claimed modem. The Examiner relies on Daniels to teach the control system element of claim 1. Dietz is relied upon to teach that use of a telephone input is known in the art of speech-to-text systems, which Appellant does not contest. Appellant has not shown any reason why, when combined with the system of Dietz, the control system of Daniels would not be capable of answering telephone calls

or taking telephone messages in the event that claim 1 was construed to require this. Appellant has therefore not established that the Examiner erred in rejecting claim 1.

Appellant argues the Examiner erred in rejecting claim 1 because Pigos is non-analogous art since it does not contemplate voice messages (Brief p. 13). Appellant's claimed invention relates to implementing systems not commonly associated with a postage metering system into a postage metering system. Some examples of those systems are speech-to-text systems and voice and text messaging systems which utilize a telephone network 40 and data center 50. The field of endeavor at the time of the invention is not limited to systems associated with voice messages as Appellant suggests. Like Appellant's invention, the Pigos system is concerned with using a central server to gather data from postage meter systems via a network. Appellant has not shown any differences in structure and/or function to demonstrate why Pigos would not commend itself to an inventor's attention in considering the invention as a whole. Appellant has therefore not established that the Examiner erred in rejecting claim 1.

Appellant argues that the Examiner erred in rejecting claim 5 because Dietz does not contemplate parsing in order to highlight critical data. Appellant additionally argues that the Examiner erred in rejecting claim 6 because Dietz does not contemplate that the parsing parameter is names. Appellant admits that Dietz uses voice cues to highlight critical data by bolding the output text. In our view this is all that claim 5 requires. Furthermore, with respect to parsing of names in the system of claim 6, it can readily be seen that names, presumably proper names, are merely non-

functional descriptive matter that cannot impart patentability to an otherwise obvious system. That Dietz possess the capability to bold or otherwise highlight portions of captured text is not in dispute. The type of text whether it be names, pronouns, adverbs or whatever does not impart nonobviousness. *See e.g., In re Ngai*, 36 7 F.3d 1336, 1339, (Fed. Cir. 2004); *Cf. In re Lowry*, 32 F.3d 1579 (Fed. Cir. 1994).

In asserting that the Examiner erred in rejecting claims 2-3, 11-12 and 20-21 under 35 U.S.C. 103(a) over Daniels in view of Dietz and Pigos and in further view of Kulpa (Br. p. 13-14), Appellant individually argues only claim 2. Accordingly claims 3, 11-12 and 20-21 will stand or fall with claim 2.

Appellant argues that the Examiner erred in rejecting claim 2 because Daniels does not contemplate or suggest initiating printing of the print message. (Br. p. 14). The Examiner relies on Daniels to teach a control system in communication with a printer (Fact 2). Appellant has not supported this argument with any reasoning to establish the control system connected to the printer of Daniels would not be capable of initiating printing of a print message. Appellant has not contested that Daniels discloses a control system operative to control a printer for common print operations including feeding and initiating printing. The exact text of the message printed would appear to be irrelevant in a system claim such as claim 2. This is simply a case of Appellant attempting to distinguish the claimed system from that of the prior art based on a new use. However, it is well settled that a new use for an old product does not make a claim to the

old product patentable. See *Schreiber* at 1477. Appellant has therefore not established that the Examiner erred in rejecting claim 2.

In asserting that the Examiner erred in rejecting claims 4, 7-8, 13, 16-17, 22 and 25-26 under 35 U.S.C. 103(a) over Daniels in view of Dietz and Pigos and Kulpa and in further view of Doeberl, Appellant individually argues only claims 4 and 7-8. With respect to claims 7 and 8, Appellant repeats the arguments addressed above with respect to claims 5 and 6, respectively. These arguments remain unpersuasive for the same reasons as those discussed above with respect to claims 5 and 6. Claims 7-8, 13, 16-17, 22 and 25-26 will stand or fall with claim 4.

With respect to claim 4, Appellant notes that the Examiner has put together a five reference rejection. The number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. Appellant additionally asserts (Brief p. 14) that none of the references discloses, teaches or suggests “strip tape.” The Examiner relies upon Doeberl to teach strip tape (Final Rej. p. 7). Appellant does not address the teachings of Doeberl and therefore has not established that the Examiner erred in relying on Doeberl to teach this feature.

In asserting that the Examiner erred in rejecting claims 9, 18 and 27 under 35 U.S.C. 103(a) over Daniels in view of Dietz and Pigos and Kulpa and Doeberl and in further view of McCutcheon, Appellant individually argues only claim 9. Accordingly claims 18 and 27 will stand or fall with claim 9.

Appellant argues that the Examiner erred in rejecting claim 9 because none of the applied references discloses, contemplates or suggests header

information including a duration indication and a message number indication. Daniels discloses a control system capable of printing (Fact 2) and McCutcheon teaches that it is known in the art to record and print header information (Fact 8). Appellant has not supported this argument by demonstrating any reason why the control system of Daniels, when combined with the teachings of McCutcheon would not be capable of creating and printing header information. Including a duration and message number indication in the header information is a matter of design choice which does not impart patentability to the claim. Furthermore, printed duration and message number information are merely non-functional descriptive matter that cannot impart patentability to an otherwise obvious system. Appellant has therefore not established that the Examiner erred in rejecting claim 9.

CONCLUSIONS OF LAW

On the record before us, Appellant has not established that the Examiner erred in rejecting;

1. claims 1, 5-6, 10, 14-15, 19 and 23-24 under 35 U.S.C. 103(a) over Daniels in view of Dietz and further in view of Pigos;
2. claims 2-3, 11-12 and 20-21 under 35 U.S.C. 103(a) over Daniels in view of Dietz and Pigos and further in view of Kulpa;
3. claims 4, 7-8, 13, 16-17, 22 and 25-26 under 35 U.S.C. 103(a) over Daniels in view of Dietz and Pigos and Kulpa and further in view of Doeberl; and
4. claims 9, 18 and 27 under 35 U.S.C. 103(a) over Daniels in view of Dietz and Pigos and Kulpa and Doeberl and further in view of McCutcheon.

DECISION

For the above reasons, the Examiner's rejection of claims 1-27 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

Vsh

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